



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,346	11/18/2003	Hiromitsu Kato	16869P-097400US	8191

20350 7590 02/13/2007
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
----------	--------------

2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/717,346	KATO ET AL.	
	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 describes a system that is described in the specification as being software only (page 13, paragraph [0070]). Claim 12 is drawn to software only.

“Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component.” (MPEP 2106). When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 6 recites the limitation "the group encryption key" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2132

6. Claim 10 recites the limitation "the group encryption key" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3-7, 9, 11, 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sorvari, U.S. Publication No. 2004/0043758. Referring to claims 1, 9, 11, 12, Sorvari discloses a system and method of providing services to a wireless client wherein a menu of available services is displayed to the user on the wireless device ([0061]). The user inputs a command to select a service to be accessed from the menu ([0062]), which meets the limitation of prompting the user to select a service from a provided service menu. The services are provided to the wireless device using the WAP protocol ([0050] & [0058] & [0221] & [0223]), which meets the limitation of acquiring a service logic where specifications for implementing the selected service are described. A network server provides the wireless device with the URLs for all the services listed in the menu ([0064] & [0192]), which meets the limitation of selecting devices having functions required for carrying out the service based on the service logic according to profile information. The user selects the appropriate URL of the desired service ([0342]), which is translated into an HTTP request and sends it over the Internet to the server providing the service ([0343-0344]). The server handles the request just like any other HTTP request received over the

Art Unit: 2132

Internet and returns and HTML page back to the gateway ([0345]), which meets the limitation of extracting service components involving configuration information for the functions based on the service logic. The gateway translates the HTML file into WML that is delivered to the wireless device ([0346-0347]), which meets the limitation of generating adaptors from the extracted service components, delivering the generated adaptors to the devices which are to carry out the service, receiving the adaptors to carry out the service according to the information in the adaptors. The wireless device contains a wireless identity module used to authenticate the user ([0339] & Figure 12, element 1208), which meets the limitation of acquiring the right to use the selected functions.

Referring to claim 3, Sorvari discloses that the wireless device contains a wireless identity module used to authenticate the user ([0339] & Figure 12, element 1208), which meets the limitation of authenticating the user when the user makes access and selects functions.

Referring to claim 4, Sorvari discloses that the wireless device contains WAP software containing components necessary to implement the WAP client on the wireless device ([0338]). These components include a WML browser and other application programs to implement a variety of communications applications ([0338]), which meets the limitation of the devices manage function types for identifying the functions in common and the attributes of the functions.

Referring to claim 5, Sorvari discloses that the network server maintains the URL of the services (Figure 9H), location information on the services (Figure 9F), right to use information (Figure 13, 1306), the function types notified from the device (Figure 9H), and attributes (Figure 9H).

Referring to claim 6, Sorvari discloses that the server maintains a user database (Figure 13, elements 1313 & 1305), which meets the limitation of service users. The server maintains a list of past used services for the users (Figure 9F), which meets the limitation of service management numbers, the identifiers of presently used functions, the identifiers of functions which can be used in the service. The system uses a public key infrastructure that associates public/private key pairs with each party involved in the transactions ([0339]), which meets the limitation of the group encryption key.

Referring to claim 7, Sorvari discloses that the user selects the appropriate URL of the desired service ([0342]), which is translated into an HTTP request and sends it over the Internet to the server providing the service ([0343-0344]). The server handles the request just like any other HTTP request received over the Internet and returns an HTML page back to the gateway ([0345]), which meets the limitation of the service components contain information on the function as the targets of setting. The HTML pages can contain JavaScript ([0337]), which meets the limitation of programs to be downloaded to the devices having the functions, and the details of connection setting for the application interfaces of the functions and the programs.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2132

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2, 8, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorvari, U.S. Publication No. 2004/0043758, in view of McMorris, U.S. Publication No. 2003/0163567. Referring to claim 2, Sorvari does not disclose transmitting the WML pages to the wireless device with a certificate containing the public key of the service provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a public key certificate along with the WML pages in order to prevent man in the middle attacks as taught by McMorris ([0003]).

Referring to claim 8, Sorvari discloses that the gateway translates the HTML file into WML that is delivered to the wireless device ([0346-0347]), which meets the limitation of the adaptor contains the service component, service identification number. Sorvari does not disclose transmitting the WML pages to the wireless device with a certificate containing the public key of the service provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a public key certificate along with the WML pages in order to prevent man in the middle attacks as taught by McMorris ([0003]).

Referring to claims 10, Sorvari discloses a system and method of providing services to a wireless client wherein a menu of available services is displayed to the user on the wireless

Art Unit: 2132

device ([0061]). The user inputs a command to select a service to be accessed from the menu ([0062]), which meets the limitation of requesting the server to change the function to be used with the service identification number of the currently used service and the group encryption key for use in the service attached to the request, verifying whether the service identification number and the group encryption key are matched with those registered, determining whether there is conflict in use of the function to change to which is requested. The services are provided to the wireless device using the WAP protocol ([0050] & [0058] & [0221] & [0223]). A network server provides the wireless device with the URLs for all the services listed in the menu ([0064] & [0192]), which meets the limitation of searching for another function if the right to use is not transferable and request to change the function again. The user selects the appropriate URL of the desired service ([0342]), which is translated into an HTTP request and sends it over the Internet to the server providing the service ([0343-0344]). The server handles the request just like any other HTTP request received over the Internet and returns an HTML page back to the gateway ([0345]). The gateway translates the HTML file into WML that is delivered to the wireless device ([0346-0347]). The wireless device contains a wireless identity module used to authenticate the user ([0339] & Figure 12, element 1208), which meets the limitation of inquiring of the present holder of the right to use about transfer of the right to determine whether the right to use is transferable if there is conflict, acquiring the right to use if transferable. Sorvari does not disclose transmitting the WML pages to the wireless device with a certificate containing the public key of the service provider. It would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit a public key certificate along with the WML pages in order to prevent man in the middle attacks as taught by McMorris ([0003]).

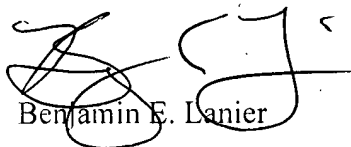
Art Unit: 2132

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Benjamin E. Lanier